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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/526,249

08/03/2005

Jean-Luc Girardet

18545-720.831

6456

21971

7590

01/04/2010

WILSON, SONSINI, GOODRICH & ROSATI
650 PAGE MILL ROAD
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EXAMINER

FRAZIER, BARBARA S

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

01/04/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/526,249	Applicant(s) GIRARDET ET AL.	
	Examiner BARBARA FRAZIER	Art Unit 1611	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: 52.
 Claim(s) objected to: _____.
 Claim(s) rejected: 46 and 53.
 Claim(s) withdrawn from consideration: 22.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☒ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☒ Other: See Continuation Sheet.

/Ashwin Mehta/
Primary Examiner, Technology Center 1600

/B. F./
Examiner, Art Unit 1611

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are not persuasive for overcoming the outstanding rejections. In response to Applicant's request to withdraw the finality of the previous rejection (under 35 USC 103(a) over Simoneau et al), it is noted that the rejection was necessitated by Applicant's amendment, and therefore finality is proper. In response to Applicant's declaration by Dr. Jean-Luc Girardet and arguments that Applicants have provided evidence that they conceived of the invention before the effective date of the cited reference, the declaration is insufficient for overcoming the rejection because the exhibits provided with the declaration (the pending claims and the cited reference) do not constitute evidence sufficient to demonstrate conception of the invention. MPEP 715.07 states that the essential thing to be shown under 37 CFR 1.131 is priority of invention, and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. A general allegation that the invention was completed prior to the date of the reference is not sufficient. Similarly, a declaration by the inventors to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. See MPEP 715.07 for further guidance. Accordingly, the declaration has not been entered (see #9, above), and the 103 rejection is maintained. New claim 53 falls within the scope of claim 46 and would also be rejected for reasons of record and stated above. The Examiner notes that the effective filing date of the claims is the filing date of PCT/US03/27433, 08/22/2003; Applicants are not entitled to the filing date of priority document PCT/US02/26816 (8/23/2002) because the currently claimed compounds, specifically where R2 is substituted naphthyl, are not disclosed in the priority document. In response to Applicant's arguments regarding the double patenting rejections, it is noted that, since no allowable subject matter has been indicated, the provisional rejection based on copending application 11/661,079 is maintained for reasons of record; however, the provisional rejection based on copending application 12/114,467 is withdrawn because application '467 is abandoned (see #13, below).

Continuation of 13. Other: The provisional obviousness-type double patenting rejection based on copending application 12/114,467 is withdrawn because application 12/114,467 is now abandoned.